

REMARKS

This Application has been carefully reviewed in light of the final Office Action electronically sent July 12, 2007. Claims 1-35 are pending and rejected in the application. Applicants submit that the pending claims are patentably distinguishable over the cited references for the reasons given below. Applicants, therefore, respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,771,381 issued to Jones et al. ("*Jones*") in view of U.S. Publication No. 2002/0150079 issued to Zabawskyj et al. ("*Zab*").

Claim 1 of the Application recites the following limitations:

A method for provisioning a network element, comprising:
providing a custom default file and a standard default file in a network element, the custom default file comprising one or more default parameters of a same type as, but having a different value from, corresponding default parameters in the standard default file, wherein the default parameters are associated with commands used to provision the network element for a telecommunications service;
determining service parameters for the telecommunications service based on default parameters of the standard default file as modified by overriding default parameters of the custom default file; and
establishing the telecommunications service based on the service parameters.

Independent Claims 12, 23, and 34 recite similar, although not identical, limitations.

To establish a *prima facie* case of obviousness, the references must teach or suggest all elements of the rejected claims and it must have been obvious to one of ordinary skill in the art at the time of invention to combine or modify the references. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, No. 04-1350 (2007); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to combine these references in the manner proposed by the Examiner.

The Office Action contends that although *Jones* does not disclose anything about determining service parameters for a telecommunications service and establishing a telecommunications service, it would have been obvious to combine the system of user configuration files of *Jones* with the teachings of *Zab* regarding the generation, provisioning and execution of applications in telecommunication networks. More particularly, the Office Action asserts that the motivation for combining these references “would have been to provide open service creation environment which provides developers the ability to generate and provision applications in a telecommunication network.” However, the Office Action fails to provide support for this conclusory statement and fails to indicate how these references could be combined in any manner.

In *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court clarified the appropriate standard to use when determining obviousness. 550 U.S. ___, No. 04-1350 (2007). “The [obviousness] analysis is objective: ‘Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.’” *Id.* (citing *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459 (1966)).

A “principal reason for declining to allow patents for what is obvious” is to prevent individuals from obtaining a patent “for a combination which only unites old elements with no change in their respective functions.” *Id.* However, the Supreme Court clarified that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* “[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* While not a rigid test, a showing of a “teaching, suggestion, or motivation” to combine or modify prior art provides helpful insight in determining whether it would have been obvious to combine references. *Id.* “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *Id.* (citing *Graham*, 383 U.S. at 36).

In the present case, the Examiner has not clearly articulated the differences between the prior art and the claims at issue or the level of ordinary skill in the art. Second, the Examiner provides no indication that the claims “only unite old elements with no change in their respective functions.” Third, the Examiner has not shown a teaching, suggestion, or motivation to combine *Jones* and *Zab* in the manner suggested. Rather, the Examiner's asserted motivation is comprised merely of a conclusory statement as to the advantage of the proposed combination. Furthermore, this asserted advantage of the proposed combination is something that *Zab* already states that it provides on its own without any modification (see Paragraph 23). Therefore, Applicants do not understand how the single sentence in the Office Action explains in any way why one of skill in the art would be motivated to combine *Jones* with *Zab*. For example, the Office Action does not explain why one of skill in the art would be motivated to use a standard default file and a custom default file, which the Office Action asserts are disclosed on *Jones*, in association with the teachings of *Zab*.

Applicants respectfully submit that the Supreme Court is clear that the type of argument provided in the present Office Action is insufficient to establish obviousness: “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, No. 04-1350 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Office Action has simply not presented any “articulated reasoning with some rational underpinning” that it would have been obvious to make the proposed combination.

For at least these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness. Therefore, Applicants request that the rejections of Claims 1, 12, 23, and 34 be withdrawn.

In addition to being allowable as depending from one of independent Claims 1, 12, and 23, many of the dependent claims are further allowable because *Jones* does not disclose the additional limitations taught by these claims. As an example only, Claim 9 recites that “the custom default file comprises default parameters of a type selected from a group consisting of threshold driven parameters and non-threshold parameters.” Claims 20 and 31 recite similar limitations. For a teaching of this limitation, the Office Action refers to Figure

7 and Column 8, lines 35-55 of *Jones*. As noted in Applicants' previous Response, Applicants cannot see, and neither Office Action has explained, how this passage and figure disclose the recited limitation. Applicants submit that there is clearly no disclosure of the recited limitations. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 9, 20 and 31.

As another example, Claim 10 further recites that the threshold driven parameters recited in Claim 9 comprise a set of thresholds for a plurality of communication types. Claims 21 and 32 recite similar limitations. For a teaching of this limitation, the Office Action again refers to Figure 7 and Column 8, lines 35-55 of *Jones*. As noted in Applicants' previous Response, Applicants cannot see, and neither Office Action has explained, how this passage and figure disclose the recited limitation. Applicants submit that there is clearly no disclosure of the recited limitations. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 10, 21 and 32.

Furthermore, Claim 11 recites that the non-threshold parameters recited in Claim 9 comprise parameters associated with a category selected from a group consisting of allow and inhibit monitoring category, allow and inhibit COMM monitoring category, initialize monitoring category, set threshold T1 clock category, edit system category, enter ethernet category, edit ethernet category, enter clock category, and edit clock category. Independent Claim 35 and dependent Claims 22 and 33 recite similar limitations. For a teaching of this limitation, the Office Action refers to Column 5, lines 16-32 of *Jones*, explaining that this passage discloses that a choice by the user to edit and customize the system is provided. As noted in Applicants' previous Response, this passage does not disclose any of the specific parameter categories recited in these claims. Applicants submit that there is clearly no disclosure of the recited limitations. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 11, 22, 33 and 35.

CONCLUSION

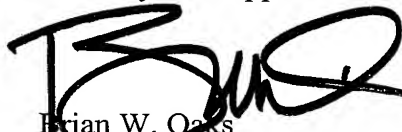
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants hereby take an extension of time for responding to the final Office Action dated July 12, 2007 for one (1) month from October 12, 2007 to November 12, 2007. Applicants believe no other fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Brian W. Oaks
Reg. No. 44,981

Date: October 15, 2007

Correspondence Address:

Customer No. 05073